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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/502,412	07/23/2004	Takashi Yasukochi	KUZ-0018	3951
7590 Jane Massey Licata Licata & Tyrrell 66 East Main Street Marlton, NJ 08053		05/29/2007	EXAMINER CHEUNG, WILLIAM K	
			ART UNIT 1713	PAPER NUMBER
			MAIL DATE 05/29/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/502,412	Applicant(s) YASUKOCHI ET AL.	
	Examiner William K. Cheung	Art Unit 1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,5,7 and 9-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2,5,7,9-14 and 16-25 is/are rejected.
- 7) ☒ Claim(s) 15 and 26 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. In view of the amendment filed March 5, 2007, new claims 10-26 have been added. Claims 2, 5, 7, 9-26 are pending.

Claim Objections

2. Claim 20 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 20 is broader than claims 2 and 19.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 13, 14, 24, 25 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for Estradiol and norethisterone, does not reasonably provide enablement for other drugs. The specification does not enable any

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person skilled in the art to which it pertains, or with which it is most nearly connected, to make/use the invention commensurate in scope with these claims. Claims 13, 14, 24, 25 are broadly claiming various families of drugs which have not been disclosed adequately in the specification to enable one of ordinary skill in art to make/use the claimed invention.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 13, 20, 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 20 (line 2-3) recites the limitation "the crosslinking sites". There is insufficient antecedent basis for this limitation in the claim.

Claim 13 (line 19), claim 24 (line 19), the recitations "traditional Chinese preparations" is considered indefinite. What is it?

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 2, 5, 7, 9, 16-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Matsumoto et al. (US 5,532,373) for the reasons adequately set forth from paragraph 4 of the office action of December 4, 2006.

Matsumoto et al. (col. 1, line 12-33) disclose a photopolymerizable composition for producing lithographic sheets or films, resin reliefs, resists or photomasks or printed circuit board manufacture, black and white or color transfer development sheets of development sheets. Further, Matsumoto et al. (col. 27, line 65-67) disclose that the composition comprises polyols, a lower alcohol (col. 29, line 21; col. 38, line 10-13), and crosslinking agent such as boric acid (col. 36, line 4). Matsumoto et al. (col. 1, line 12-33; col. 29, line 51 to col. 30, line 12) clearly disclose a process where the disclosed composition is coated (or spread) onto a film which as a support for the disclosed composition, and subsequently thermally crosslink either simultaneously with or followed by laminating to a support because such process are typical procedures in the manufacturing of printed circuit board with photoresists.

Since the disclosed composition is coated onto a support film, the examiner has a reasonable basis that the disclosed composition is capable adhesive properties.

Regarding the claimed "pressure-sensitive" feature, the examiner believes that this limitation is inherently possessed in Matsumoto et al. in view of substantially identical composition disclosed in Matsumoto et al. and the composition being claimed.

Regarding the newly added "a drug" feature, "a drug" as defined by Merriam-Webster's Collegiate Dictionary, 10th Edition, (1996), can be a substance used in dyeing or chemical operations. Since process of Matsumoto et al. (col. 33, line 34-60) involves the addition of a dye, the examiner has a reasonable basis that the newly added "a drug" feature in the claims has been met by Matsumoto et al.

Regarding claim 2 which claims "dissolving a drug and a hydroxyl group- or carboxyl group-containing polymer in a lower alcohol" or claim 9 which claims "crosslinking agents selected from the group consisting of metal alcoholates, boric acid, borate and borate ester in a lower alcohol", Matsumoto et al. (col. 28, line 58-66) clearly teach that the lower alcohol can be used as a solvent for all the disclosed ingredients which includes the "dissolving a drug and a hydroxyl group- or carboxyl group-containing polymer in a lower alcohol" feature of claim 2 and the "crosslinking agents selected from the group consisting of metal alcoholates, boric acid, borate and borate ester in a lower alcohol" of claim 9.

Matsumoto et al. contain all the limitations of claims 2, 5, 7, 9, 16-20. Claims 2, 5, 7, 9, 16-20 are anticipated.

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In response to the recited "for the production of a medical patch" of claims 2 and 9, applicants must recognize that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Applicant's arguments filed March 5, 2007 have been fully considered but they are not persuasive. Applicants argue that Matsumoto et al. do not disclose the claimed "one or more crosslinking agents", applicants must recognize that Matsumoto et al. (col. 22, line 7-23; col. 40, line 23; col. 41, line 5; col. 43, Table 6) clearly disclose multi-functional acrylates that are considered crosslinkers.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
10. Claims 10-12, 21-23 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Matsumoto et al. (US 5,532,373).

Set forth from paragraph 4 of instant office action, the process of the claimed invention is considered anticipated. Regarding the claimed "crosslinking" is carried out at a specific temperature and the approximate time for the crosslinking process, in view of the substantially identical composition disclosed in Matsumoto et al. and the composition used in the process as claimed, the examiner has a reasonable basis that the claimed temperature at which the crosslinking is carried out is inherently possessed in Matsumoto et al. because substantially identical composition should result in substantially identical exothermic reaction which give rise to substantially identical temperature ranges or time ranges for the claimed crosslinking process.

Allowable Subject Matter

11. Claims 15, 26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to William K. Cheung whose telephone number is (571) 272-1097. The examiner can normally be reached on Monday-Friday 9:00AM to 2:00PM; 4:00PM to 8:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David WU can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



William K. Cheung, Ph. D.

Primary Examiner

May 24, 2007

**WILLIAM K. CHEUNG
PRIMARY EXAMINER**